

REMARKS

Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks. With this amendment, Applicant has cancelled previously pending claims without prejudice and has added independent claims 21 and 32 as well as dependant claims 22-31 and 33-43. Applicant respectfully submits that these claims are patentable over the art cited.

While Applicant disagrees with the Examiner's positions, Applicant submits that the 35 U.S.C. § 112 rejections are moot because the previously pending claims have been cancelled. Accordingly, no further discussion of these issues is necessary.

Regarding the rejection of claims 1-9 and 11-15 under 35 U.S.C. § 103, Applicant respectfully continues to traverse this rejection. Applicant has replaced the previously pending claims in an attempt avoid the indefiniteness rejections and the effect of the indefiniteness rejections on the interpretation of the claims by the Examiner, not for reasons related to the actual patentability of the claims beyond the indefiniteness rejections.

In paragraph 8 of the Advisory Action dated September 12,

2005, the Examiner states, "Proof that using a lap structure (including a clean surface area) to ensure continuous impermeablity [sic] is well known provided in McGroarty for the reasons of record." Applicant continues to object to this assertion and requests clarification of these reasons.

Applicant agrees that the lapping roofing materials is well known. However, the present invention is not simply a lapped roofing material; rather it features a unique and non-obvious combination of several layers disposed on BOTH the top and the bottom surfaces of the substrate. Traditional roofing shingles are lapped, however, they DO NOT have this unique and non-obvious combination of limitations. Applicant requests that the Examiner explain how the concept of lapping roofing materials makes the present invention obvious.

In paragraph 6 of the Office Action dated May 18, 2005, the Examiner states,

McGroarty teach[es] that the "lap" structure of one sheet "lapping" another sheet over the clean surface area of the another [sic] sheet is a well known structure in the art of roof waterproofing, one of ordinary skill in the art would have recognized to have set the particular orientation of the edge portion 13 depending on the particular desired end result. (Paragraph 6 of the present Office Action) (Emphasis added.)

In the prior Office Action dated July 29, 2004, the Examiner stated that the desired end result of the modification to Kennepohl is to "provide a continuous impervious layer as taught by McGroarty et al." (Emphasis added.) Applicant submits that this conclusion is improper and **does not provide any support for the proposed modification** since the roofing material disclosed by Kennepohl, Simpson, and McGroarty each already provide "a continuous impervious layer".

The independent claims generally recite a rolled roofing material comprising a substrate saturated with a first asphalt composition and including a first and a second region. The first region features a first layer of a second asphalt composition contacting an upper surface of the second region and a second layer of an adhesive composition contacting a lower surface of the second region. The second region is disposed along at least a first edge of the substrate and features an upper and a lower surface substantially free of the first and second asphalt compositions. Granules contact an outer surface of the second layer.

The Examiner acknowledges that neither Kennepohl nor Simpson disclose or suggest these limitations. Kennepohl discloses a

traditional shingle saturated with asphalt and having a layer of asphalt and a layer of granules coating the entire top surface and states, "Asphalt singles of this type constitute the most common roofing material for private residential buildings." (Column 1, lines 43-46.) Kennepohl does not disclose or suggest anything on the bottom surface of the shingle. The novel aspect of Kennepohl (back in 1975) was the asphalt compositions, not the structure of the shingle. Again, there nothing in Kennepohl that discloses or suggests the limitations recited above.

With respect to Simpson, the Examiner cites the underlayment 90 (FIG. 9) disclosed in Simpson and in particular the adhesive layer 94. The underlayment 90 of Simpson does not have anything coated on its top surface except when a roofing material is applied over it, in which case the roofing material covers the entire top surface of the underlayment 90. The bottom surface of the underlayment 90 is entirely coated with an adhesive 94. Again, there nothing in Simpson that discloses or suggests the limitations recited above.

The Examiner then cites McGroarty. As argued previously, however, McGroarty merely discloses a plastic layer 10 (not an asphalt saturated substrate) having region 13 disposed on the

bottom surface of the waterproofing sheet 10. Applicant submits that McGroarty fails to provide support for the limitations recited above.

Firstly, each of the independent claims recites, generally, a substrate saturated with a first asphalt that includes an adhesive composition disposed on a portion of the bottom surface of the substrate. Moreover, the independent claims recite, generally, an end region disposed along the bottom surface of the substrate that does not include this adhesive composition.

The bentonite layer 11 of McGroarty IS NOT an adhesive composition and has no adhesive properties at all. Thus, it CANNOT READ on this limitation of the independent claims. Since McGroarty does not disclose or suggest even having an adhesive composition on the bottom surface of the substrate, it therefore CANNOT disclose or suggest having a region along at least one edge that does not have a layer of an adhesive composition. To suggest otherwise is to ignore the fact that McGroarty fails to teach or suggest having even having a layer of an adhesive composition.

In addition, the independent claims also recite that the TOP surface also includes a region of a second asphalt and an edge region free from the first and the second asphalt. Even assuming,

arguendo, that McGroarty discloses a substrate saturated with a first asphalt that includes an adhesive composition disposed on a portion of the bottom surface of the substrate and an end region along the bottom surface of the substrate that does not include this adhesive composition, McGroarty unequivocally discloses this ONLY on the bottom, not on the top surface. The layer of bentonite disclosed in McGroarty is disposed ONLY disclosed on the bottom surface. The top surface of McGroarty does NOT have an asphalt composition covering ANY part of it (nor does any other part of McGroarty for that matter). For the reasons discussed in length in the previous responses, the edge region 13 and bentonite layer 11 of McGroarty MUST BE and COULD ONLY BE disposed on the bottom surface since exposing the bentonite layer 11 to the weather would cause the bentonite layer 11 to expend.

As mentioned above, it is only when the underlayment 90 of McGroarty is covered with a roofing material that the top surface of the underlayment 90 has anything covering it whatsoever. However, when the roofing material is applied on top of the underlayment 90, the ENTIRE TOP surface of the underlayment 90 just like Kennepohl and Simpson. Thus, there is NOTHING in McGroarty that suggests a top surface having a region covered by

an asphalt composition and an edge region disposed along the top surface that is substantially free of the first and second asphalt compositions. Accordingly, Applicant requests that the Examiner explain WHERE there is support for the proposed modification of Kennepohl to features an edge region on BOTH the top and bottom surfaces of the substrate that is free of the first and second asphalt compositions as well as the adhesive composition.


In addition, Applicant requests the Examiner to address where there is support for modifying the adhesive layer disclosed in Simpson based on McGroarty. As discussed above, the bentonite layer disclosed in McGroarty IS NOT an adhesive layer and has NO adhesive properties.

Accordingly, Applicant submits that the combination of the references cited by the Examiner does not disclose or suggest all the limitations of the independent claims. The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

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Respectfully submitted,

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